UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,487	01/29/2004	Donald Carroll Roe	5494CRD2	8729

27752 7590 01/17/2007

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL BUSINESS CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER	
AHMED, HASAN SYED	
ART UNIT	PAPER NUMBER
1615	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/769,487	ROE ET AL.	
	Examiner	Art Unit	
	Hasan S. Ahmed	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,8,10,11 and 28-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,8,10,11 and 28-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- Receipt is acknowledged of applicants' amendment/remarks, which were filed on 26 October 2006.
- The amendment filed on 26 October 2006 has been entered.
- Applicants' arguments have been considered but are moot in view of the new grounds of rejection.

* * * * *

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 10, 11 and 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 6,861,571).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 10);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

  (i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient

comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

(ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35 °C (*see* claim 10; col. 19, lines 54-67);

- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 10);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 54-67);
- the petrolatum emollient of instant claim 10 (*see* claim 14);
- the mineral oil emollient of instant claim 11 (*see* claim 15);
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 54-67);
- the macroscopic regions of instant claim 29 (*see* col. 20, line 25);
- the microscopic regions of instant claim 30 (*see* col. 20, line 25); and
- the stripes, droplets, dots, or mixtures thereof of instant claim 31 (see col. 20, lines 36-44).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to

stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

2. Claims 1, 2, 8, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 6,426,444).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 9);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

  (i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

  (ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing

agent has a melting point of at least about 35 °C (*see* claim 9; col. 19, lines 50-56);

- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 9);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 50-56);
- the lotion applied to the liquid pervious topsheet in the form of a plurality of stripes that are separated by a plurality of stripes having no lotion of instant claim 8 (*see* claim 9);
- the petrolatum emollient of instant claim 10 (*see* claim 3);
- the mineral oil emollient of instant claim 11 (*see* claim 4); and
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 50-56).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

3. Claims 1, 2, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 6,118,041).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 1);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

  (i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

  (ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C (*see* claim 1; col. 19, lines 50-56);
- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 1);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 50-56);
- the petrolatum emollient of instant claim 10 (*see* claim 3);

- the mineral oil emollient of instant claim 11 (*see* claim 4); and
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 50-56).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

4. Claims 1, 2, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 6,586,652).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 1);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

(i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

(ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C (*see* claim 1; col. 19, lines 26-33);

- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 1);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 26-33)
- the petrolatum emollient of instant claim 10 (*see* claim 3);
- the mineral oil emollient of instant claim 11 (*see* claim 4); and
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 26-33).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v.*

Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

5. Claims 1, 2, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 5,635,191).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 1);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

  (i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

  (ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing

agent has a melting point of at least about 35°C (*see* claim 1; col. 19, lines 19-28);

- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 1);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 19-28)
- the petrolatum emollient of instant claim 10 (*see* col. 1, line 43);
- the mineral oil emollient of instant claim 11 (*see* col. 1, line 43); and
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 19-28).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

6. Claims 1, 2, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 5,643,588).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 1);

- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

  (i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

  (ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C (*see* claim 1; col. 19, lines 34-41);

- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 1);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 34-41)
- the petrolatum emollient of instant claim 10 (*see* claim 3);
- the mineral oil emollient of instant claim 11 (*see* claim 4); and
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 34-41).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

7. Claims 1, 2, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 5,607,760).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 1);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

  (i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient

comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

(ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C (*see* claim 1; col. 19, lines 22-29);

- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 1);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 22-29)
- the petrolatum emollient of instant claim 10 (*see* col. 1, line 48);
- the mineral oil emollient of instant claim 11 (*see* col. 1, line 48); and
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 22-29).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

8. Claims 1, 2, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 5,609,587).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 1);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

  (i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

  (ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C (*see* claim 1; col. 24, lines 25-32);
- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 1);

- the nonuniform manner of instant claim 2 (*see* col. 24, lines 25-32)
- the petrolatum emollient of instant claim 10 (*see* col. 1, line 48);
- the mineral oil emollient of instant claim 11 (*see* col. 1, line 48); and
- the nonuniform manner of instant claim 28 (*see* col. 24, lines 25-32).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

9. Claims 1, 2, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 5,968,025).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 1);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion

coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

(i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

(ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing agent has a melting point of at least about 35°C (*see* claim 1; col. 19, lines 57-65);

- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 1);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 57-65)
- the petrolatum emollient of instant claim 10 (*see* claim 4);
- the mineral oil emollient of instant claim 11 (*see* claim 5); and
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 57-65).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to

stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

*

10. Claims 1, 2, 10, 11, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe (U.S. Patent No. 6,825,393).

Roe discloses an article comprising:

- the liquid impervious backsheet of instant claim 1 (*see* claim 1);
- the liquid pervious, hydrophilic topsheet joined to said backsheet of instant claim 1, said topsheet having an inner surface oriented toward the interior of said article and an outer surface oriented toward the skin of the wearer when said article is being worn, wherein at least a portion of said topsheet outer surface comprises an effective amount of a nonuniformly applied lotion coating which is semi-solid or solid at 20°C and which is partially transferable to the wearer's skin, said lotion coating comprising:

  (i) from about 10 to about 95% of a substantially water free emollient having a plastic or fluid consistency at 20°C, wherein said emollient comprising a member selected from the group consisting of petroleum-based emollients, fatty acid ester emollients, alkyl ethoxylate emollients, and mixtures thereof;

  (ii) from about 5 to about 90% of an agent capable of immobilizing said emollient on said outer surface of the topsheet, wherein said immobilizing

agent has a melting point of at least about 35°C (*see* claim 1; col. 19, lines 44-51);

- the absorbent core positioned between said topsheet and said backsheet of instant claim 1 (*see* claim 1);
- the nonuniform manner of instant claim 2 (*see* col. 19, lines 44-51)
- the petrolatum emollient of instant claim 10 (*see* claim 3);
- the mineral oil emollient of instant claim 11 (*see* claim 4); and
- the nonuniform manner of instant claim 28 (*see* col. 19, lines 44-51).

The limitation "feminine hygiene garment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Here, "feminine hygiene garment" is deemed an intended use of a structure.

* * * * *

Double Patenting

Statutory

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

*

1. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 10 of prior U.S. Patent No. 6,861,571. This is a double patenting rejection.

*

2. Claims 1, 8, 10, and 11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9, 3, and 4 of prior U.S. Patent No. 6,426,444. This is a double patenting rejection.

*

3. Claims 1, 10, and 11 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3, and 4 of prior U.S. Patent No. 6,118,041. This is a double patenting rejection.

*

4. Claims 1, 10, and 11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3, and 4 of prior U.S. Patent No. 6,586,652. This is a double patenting rejection.

*

5. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 5,635,191. This is a double patenting rejection.

*

6. Claims 1, 10, and 11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3, and 4 of prior U.S. Patent No. 5,643,588. This is a double patenting rejection.

*

7. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 5,607,760. This is a double patenting rejection.

*

8. Claim 1 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 5,609,587. This is a double patenting rejection.

*

9. Claims 1, 10, and 11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 4, and 5 of prior U.S. Patent No. 5,968,025. This is a double patenting rejection.

*

10. Claims 1, 10, and 11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 3, and 4 of prior U.S. Patent No. 6,825,393. This is a double patenting rejection.

*

11. Claims 1, 10, and 11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 4, and 5 of copending Application No. 10/262,036. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

*

12. Claims 1, 2, 8, 10, 11, and 28-31 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 8, 10, 11, and 28-31 of copending Application No. 10/769,439. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

* * * * *

Nonstatutory

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

*

1. Claims 8 and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,118,041 (U.S. '041). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '041 claims an article comprised of: (a) a

hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '041, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art (*see* discussion above). Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '041.

*

2. Claims 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,426,444 (U.S. '444). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '444 claims an article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 9. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '444. Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '444.

*

3. Claims 8, and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,586,652 (U.S. '652). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '652 claims an article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See*

claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '652. Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '652.

*

4. Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,861,571 (U.S. '571). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '571 claims an article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '571. Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '571.

*

5. Claims 8 and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 5,635,191 (U.S. '191). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '191 claims an article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '191, since diapers and feminine hygiene garments are considered structural and functional

equivalents in the art (*see* discussion above). Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '191.

*

6. Claims 8 and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. U.S. Patent No. 5,643,588 (U.S. '588). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '588 claims an article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '588, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art (*see* discussion above). Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '588.

*

7. Claims 8 and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,607,760 (U.S. '760). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '760 claims a disposable article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '760. Thus,

the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '760.

*

8. Claims 8 and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 5,609,587 (U.S. '587). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '587 claims a disposable article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '587. Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '587.

*

9. Claims 8 and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 5,968,025 (U.S. '025). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '025 claims an absorbent article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '025. Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '025.

*

10. Claims 8 and 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,825,393 (U.S. '393). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '393 claims an absorbent article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '393. Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '393.

*

11. Claims 8 and 29-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/262,036 ('036). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '036 claims an absorbent article comprised of: (a) a hydrophilic topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '036. Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '036. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*

12. Claims 1, 2, 8, 10, 11, and 28-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 11/300,715 ('715). Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. '715 claims an absorbent article comprised of: (a) a topsheet coated with lotion; (b) a backsheet; and (c) an absorbent core. *See* claim 1. One of ordinary skill in the art at the time of the invention would have expected a similar article from the instant claims, given the claims of U.S. '715. Thus, the instant claims for a feminine hygiene garment would have been obvious given the claims of U.S. '715. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

☆

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HUMERA N SHEIKH
PRIMARY EXAMINER
Tc-1600